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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,388	12/02/2003	Scott E. Brient	028/007	5574

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EXAMINER	
MAHAFKEY, KELLY J	

ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/726,388

Applicant(s)

BRIENT, SCOTT E.

Examiner

Kelly Mahafkey

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-91 is/are rejected.
- 7) ☐ Claim(s) 30-91 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/11/04, 2/7/05, & 12/30/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 39-99 have been renumbered 30-91.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-91 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-8, 10-20, and 25-31 (as submitted 8/8/07) of copending Application No. 11336186 ('186). Although the conflicting claims are not identical, they are not patentably distinct from each other

because both applications are directed towards substantially the same invention; both applications are directed towards an automated process of injecting a food item, including a French fry, with almost the same method. The only difference between the claims is that the instant application encompasses other food items and fillings from the '186. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the injection device as taught by '186 to inject a desired sauce or condiment, such as ketchup, syrup, cheese, barbeque sauce, ranch dressing, gravy, and hot sauce into a desired food item such as a hash brown, French toast stick, or a pancake. To do so would be an obvious design choice of one of ordinary skill in the art at the time the invention was made depending on the desired final product.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferrara (US 5337925).

Ferrara teaches a method of preparing food items comprising cooking the food item and then injecting a condiment into an interior portion of the food item. Ferrara teaches that the food material and the material that is injected into the food are only limited by the imagination of the user. Ferrara teaches that the exterior surface of the food is pierced with an injection nozzle, forming a hole in the food, and the condiment is transferred through the injection nozzle into the food. Refer specifically to Abstract, Column 1 lines 7-31, Column 3 lines 42-52, and Column 4 lines 4-20.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-19, 21-32, 38, 43, 47-50, 52-56, 71-74, 77, 84, 87-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrara (US 5337925).

Ferrara teaches of a food item which is injected with a filling, such as condiments, as discussed above. Ferrara teaches, Column 4 lines 4-7, "The varieties of materials which may be selected for the use in the device are only limited by the imagination of the user." Ferrara, exemplifies the invention a meat product, however, is silent to the other types of food items and condiments that are utilized with the invention as recited in claims 21-32, 52-56 and 71-74, to the method of cooking those food items as recited in claims 18, 19, 49, 50, and 91, and to piercing and fill the food item twice with an injection nozzle, wherein the second injection occurs at a different location and the filling is inserted into the food item substantially immediately after piercing, i.e. within one minute of piercing as recited in claims 16, 17, 47, 48, 87, 88, and 90 and to the length of time between the piercing as recited in claim 89.

Regarding other types of food items and condiments that are utilized with the invention and the method of cooking those food items, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the injection device as taught by Ferrara to inject a desired sauce or condiment, such as ketchup, syrup, cheese, barbeque sauce, ranch dressing, gravy, and hot sauce into a desired food item such as a French fry, hash brown, French toast stick, or a pancake. To do so would have been obvious to one of ordinary skill in the art at the time the invention was made depending on the desired final product and the taste and flavor wanted for the product. Furthermore, to cook the desired product after the condiment or sauce was injected into the product by conventional means, such as deep frying or baking would

have been obvious to one of ordinary skill in the art at the time the invention was made, as to do so would be routine determination of one of skill in the art depending on the desired food product chosen.

Regarding piercing the food item twice with an injection nozzle, wherein the second injection occurs at a different location on the food item and the filling is inserted into the food item substantially immediately after piercing, it would have been obvious to one of ordinary skill in the art at the time the invention was made to pierce the food item multiple times in different locations, such as at one end and the opposite end, and insert a second portion of the filling in order to ensure that the filling was dispersed on both parts or ends of the food product. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to fill the food item immediately after, such as within a minute of piercing the food product in order to make the food product through an efficient process.

Regarding the length of time between the piercing, it would have been obvious to perform the piercing steps at the substantially the same time depending on the available equipment and in order to produce the food product in an efficient manner. To do so would be within the ordinary ingenuity of one of ordinary skill in the art and would not impart a patentable distinction to the claims.

Claims 2-6, 33-37, 57-65, 75, 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrara (US 5337925) as applied to claims 16-19, 21-32, 38, 43, 47-50, 52-56, 71-74, 77, 84, 87-91 above, in view of Goroll (WO 00/16646 as translated by the USPTO September 2006).

Ferrara teaches of a condiment injected food item as discussed above. Ferrara, however, is silent to the amount of condiment injected into the food as recited in claims 2-6, 33-37, 75, and 76, to automating the filling process as recited in claims 20, 51, 57, and 62, to the injecting a single French fry or a batch of French fries as recited in claims 57, 62, and 63, to the amount of time that passes between cooking and injection of the

condiment as recited in claims 59-61, and to using a sensor, such as a temperature sensor to detect a French fry as recited in claims 64 and 65.

Goroll teaches a method of injecting condiments into French fries. Goroll teaches that after the condiment is laterally injected the French fries are frozen and then later cooked by deep frying. Goroll teaches that many flavors can be used as filling and such flavors can be determined by the consumer. Refer specifically to Page 3 paragraph 1. Goroll teaches that the amount of filling inserted into the food item is to be determined by the manufacturer, depending on if it is desirable for the food item is to have a small or large amount of filling. Refer specifically to Page 3 paragraph 2. Goroll teaches that the filling procedure can be completed with the use of an automated system (Pages 4-5 paragraph 4).

Regarding the amount of condiment injected into the food, it would have been obvious to one of ordinary skill in the art at the time the invention was made to inject a specific amount of condiment into the food item depending on the amount of condiment desired by the consumer in the food item.

Regarding automating the filling process and using a sensor, such as a temperature sensor to detect a French fry, to automate a manual process was known in the art at the time the invention was made, such as taught by Goroll. One of ordinary skill in the art at the time the invention was made would have been motivated to automate the process of Ferrara, such as by using a known sensor to detect and fill the food item, such as a temperature sensor, in order to improve the efficiency of the process. To automate a process and to choose a particular sensor appropriate for such process would be routine determination of one of skill in the art at the time the invention was made and would not impart a patentable distinction to the claims.

Regarding injecting a single French fry or a batch of at least five French fries, it would have been obvious to one of ordinary skill in the art at the time the invention was made to inject a specific number of food items depending on the desired amount of food items at the time the food items were being produced.

Regarding the amount of time that passes between cooking and injection of the condiment, it would have been obvious to one of ordinary skill in the art at the time the invention was made to inject the food item immediately after cooking in order to maintain an efficient and continuous process.

Claims 8-11, 13, 14, 39-42, 44, 45, 78-83 85, and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrara (US 5337925) as applied to claims 16-19, 21-32, 38, 43, 47-50, 52-56, 71-74, 77, 84, 87-91 above, in view of Sinnig (DE 19842546 A1 as translated by the USPTO September 2006).

Ferrara teaches of a condiment injected food item as discussed above. Ferrara, however, is silent to the injection hole dimension as restricting the flow of the condiment out of the food item as recited in claims 8, 39, and 78, to the maximum width of the injection hole as recited in claims 9-11, 40-42, and 81-83, to the maximum width of the injection nozzle as recited in claims 13, 14, 44, 45, 85, and 86.

Sinnig teaches an automated method of injecting condiments into French fries. Sinnig teaches that the size of the injection nozzle varies so as to allow the filling material to be injected in a thin or thick stream. Sinnig teaches that a variety of flavors can be injected into the food item. Refer specifically to Page 3 paragraph 6 and Page 4 paragraphs 5-8.

Regarding the injection hole dimension as restricting the flow of the condiment out of the food item, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the injection hole to restrict the flow of the condiment out of the food item. One would have been motivated to do so in order to prevent the filling from exiting the food item and causing a mess.

Regarding the maximum width of the injection hole and the maximum width of the injection nozzle, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the width of the injection hole and nozzle as taught by Sinnig depending on the desired type and amount of filling to be placed within

the food item. To do so would be routine determination of one of skill in the art at the time the invention was made and would not impart a patentable distinction to the claims.

Claims 15, 46, and 66-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrara (US 5337925) as applied to claims 16-19, 21-32, 38, 43, 47-50, 52-56, 71-74, 77, 84, 87-91 above, in view of Artzer (US 4966781)

Ferrara teaches of a condiment injected food item as discussed above. Ferrara, however, is silent to preheating the condiment prior to injecting it into the food item as recited in claims 15 and 46 and to laterally injecting the angle at a specific degree as recited in claims 66-70.

Artzer teaches an automated process for injecting food items with preheated condiments (Column 3 lines 27-36). Artzer, Figure 10, teaches that the injection occurs longitudinal, including an angle wherein the surface of the food item and the injection nozzle (58A and 58B) form an angle less than 76, 60, 45, and 30 degrees.

Regarding preheating the condiment prior to injecting it into the food item, it would have been obvious to one of ordinary skill in the art at the time the invention was made to inject a preheated condiment as taught by Artzer into a cooked food item. One would have been motivated to do so in order to inject the condiment at the same temperature of the food item, to prevent cooling of the food item and thus expedite the process of preparing the food item.

Regarding laterally injecting the angle at a specific degree, such as less than 30 degrees, it would have been obvious to one of ordinary skill in the art at the time the invention was made to inject the filling from a certain angle depending on the dimensions of the filling and the amount of filling desired; i.e. if a food item had the dimensions of 1in x 2in x 3in and 3 inches of filling was to be inserted at one time into the food, it would be obvious to one of ordinary skill in the art that the filling could not be inserted in the 1in dimensional side. To determine the injection angle for filling would be a result effective variable dependant upon the desired location of the filling based on consumer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Mahafkey whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lien Tran/
Primary Examiner
Group 1700

Kelly Mahafkey
Examiner
Art Unit 1794

A handwritten signature in black ink, appearing to be 'K. Mahafkey', with a large, sweeping flourish extending to the right.